

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q106246

Jean-Laurent LUQUET, et al.

Appln. No.: 10/767,125

Group Art Unit: 3653

Confirmation No.: 4365

Examiner: Jeremy R. SEVERSON

Filed: January 29, 2004

For: DEVICE FOR RECEIVING ENVELOPES

SUBMISSION OF APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

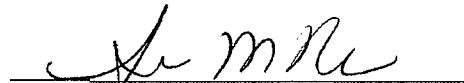
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Sir:

Submitted herewith please find an Appeal Brief. The USPTO is directed and authorized to charge the statutory fee of \$540.00 and all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

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I. REAL PARTY IN INTEREST

The real party in interest is NEOPOST TECHNOLOGIES by virtue of an assignment executed by Jean-Laurent LUQUET and Philip TORRES (hereinafter "Appellants") on April 27, 2004 and recorded in the U.S. Patent and Trade mark Office on July 14, 2004 at reel 015557 and frame 0146.

II. RELATED APPEALS AND INTERFERENCES

Upon information and belief, there are no other prior or pending appeals, interferences or judicial proceedings known to Appellants' Representative or the Assignee that may be related to, be directly affected by, or have a bearing on the Board's decision in the Appeal.

III. STATUS OF CLAIMS

Claims 1-8 are pending and are the basis of this Appeal.

Claims 1-8 stand rejected. See Claims Appendix for listing of claims.

Claim 9 was previously canceled.

IV. STATUS OF AMENDMENTS

Appellants did not amend the claims subsequent to the July 9, 2008 Final Office Action. Accordingly, all amendments, which have been made during prosecution of the present application, have been entered and are reflected in the attached Claims Appendix.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention is directed to a mail item receiving device. The features of independent claim 1 are described herein in reference to non-limiting embodiments of Appellants' specification. Also, since dependent claims 2 and 4 contain "means" recitations, such claims are also set forth.

Claim 1- Claim 1 recites a mail item receiving device 24 having a support plate 26 on which ejected mail items will accumulate (Figs. 1 and 3; pg. 4, lines 3-7). A front wall 28 on which the mail items will abut upon their ejection is joined to the support plate 26 (Fig. 3; pg. 4, lines 3-7). Two lateral walls 30, 32 are also joined to the support plate 26 (Fig. 3; pg. 4, lines 3-7). Also, a rear wall 34 configured to align the mail items once they have fallen on the support plate 26 is joined to the support plate 26 and two lateral walls 30, 32 (Figs. 3 and 4; pg. 4, lines 3-7).

The mail item receiving device 24 is configured to receive the ejected mail items from a folding and inserting machine 14, 16 (Fig. 1; pg. 3, lines 12-27). The support plate 26 includes two hollows 26A, 26B provided on either side of its longitudinal axis at a level at which the support plate 26 is joined with the front wall 28 (Fig. 3; pg. 4, lines 8-16). Each hollow 26A, 26B creates an opening between a respective lateral wall 30, 32 and the front wall 28 (Figs. 3 and 4). Finally, the rear wall 34 has a hooking means 36 configured to cooperate with feet 22A, 22B of the folding and inserting machine 14, 16 for connecting the receiving device 24 to the folding and inserting machine 14, 16 (Fig. 3; pg. 4, lines 17-23).

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Claim 2- Claim 2 recites that the hooking means 36 comprises two clips 38A, 38B which respectively clip on to two front feet 22A, 22B of the machine 14, 16 (Fig. 3; pg. 4, lines 17-23).

Claim 4- Claim 4 recites that the rear wall 34 integrating the hooking means 36 is reinforced by ribs 40 (Fig. 3; pg. 5, lines 3-8).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A.** Claims 1-3, 7 and 8 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tschiderer (US 5,363,998) in view of Ladds (US 4,155,643) and Haydock (US 2,963,761).
- B.** Claim 4 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable in view of Tschiderer, Ladds and Yamada (US 6,714,326).
- C.** Claim 5 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable in view of Tschiderer, Ladds and Firl (US 5,454,553).
- D.** Claim 6 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable in view of Tschiderer, Ladds and Yamada (JP 8-337349).

VII. ARGUMENT

I. Claims 1-3, 7 and 8 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tschiderer (US 5,363,998) in view of Ladds (US 4,155,643) and Haydock (US 2,963,761).

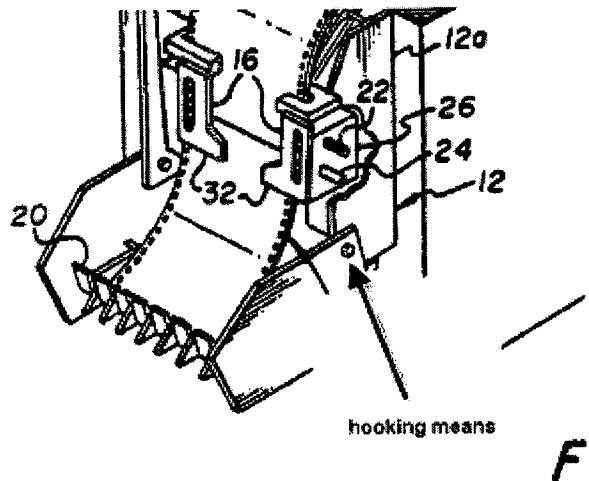
The Examiner has rejected claims 1-3, 7 and 8 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tschiderer, Ladds and Haydock.

A. Claim 1

Claim 1 recites:

 said rear wall comprises hooking means configured to cooperate with feet of a folding and inserting machine for connecting the receiving device to the folding and inserting machine

Appellants maintain that the Examiner has mischaracterized the teachings of the prior art and has therefore failed to establish a *prima facie* case of obviousness. In particular, the Examiner asserts that the primary reference, Tschiderer, teaches a “hooking means” (pg. 2 of July 9, 2008 Final Office Action). As support, the Examiner merely refers to Figure 1 of the reference without citing any particular reference numeral shown therein that is alleged to disclose the hooking means. Referring, however, to page 7 of the January 7, 2008 non-final Office Action, the Examiner provides an annotated version of a portion of Figure 1 of Tschiderer (reproduced below).



As shown above, the Examiner contends that the pins of the output tray 20 disclose a hooking means. Such pins, however, are provided on *lateral* walls of the output tray 20 as opposed to being provided on *rear* walls as recited in claim 1.

Furthermore, the pins of the output tray 20 connect to the fan fold paper feeding device 12 rather than the reproduction apparatus 10 itself. Appellants submit that Figure 1 of Tschiderer fails to show how the combination of the output tray 20 (alleged receiving device) and the fan fold paper feeding device 12 interconnected thereto, are attached to the reproduction apparatus 10. The detailed description portion of Tschiderer likewise fails to provide any teaching or suggestion as to whether such devices are either integrally formed with the reproduction apparatus 10 or are detachably connected to the reproduction apparatus 10. Thus, contrary to the Examiner's assertion, Tschiderer does not provide any teachings regarding attachment, let alone that the output tray 20 (alleged receiving device) and the fan fold paper feeding device 12

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interconnected thereto, have a “hooking” means (where such hooking means is specifically provided on a rear wall of the output tray 20 as set forth in the claim).

On page 3 of the July 9, 2008 Final Office Action, the Examiner also acknowledges that the alleged hooking means (i.e., pins) of Tschiderer is not configured to cooperate with feet of a folding and inserting machine for connecting the receiving device to the folding and inserting machine, but contends that that the clips disclosed in Haydock are equivalent to the “hooking means” disclosed in Tschiderer. As set forth above, the pins are merely provided on lateral walls of the output tray 20 and Tschiderer does not provide any teaching or suggestion regarding attachment of the combination of the output tray 20 (alleged receiving device) and the fan fold paper feeding device 12 interconnected thereto, to the reproduction device 10, let alone that an actual “hooking means” is provided for this particular attachment region. Thus, it is improper for the Examiner to assert that the undisclosed attaching means of Tschiderer is a hooking means which is in turn equivalent to the clips 22 of Haydock (see Fig. 1 of Haydock).

In addition to the above, Appellants submit that one skilled in the art would not be motivated to modify the teachings of Tschiderer to have the combination of the output tray 20 (alleged receiving device) and the fan fold paper feeding device 12 interconnected thereto, attached to the reproduction device 10 using the clips 22 of Haydock. For example, the clips 22 of Haydock require a rod element (i.e., rod 18) for attachment. As shown in Figure 1 of Tschiderer, the output tray 20 is pivotally connected to the fan fold paper feeding device 12 via the pins and it appears that the entire back side of the fan fold paper feeding device 12 is attached in some undisclosed manner to the reproduction device 10. There is no rational reason why one

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skilled in the art would attach rods to that portion of the reproduction device 10 of Tschiderer merely so that the clips 22 of Haydock could be utilized. Likewise, there is no rational reason why one skilled in the art would attach rods to the lateral walls of the output tray 20 so that the pins of the output tray 20 are exchanged with the alleged hooking means of Haydock.

Furthermore, regarding the claimed cooperation of the hooking means with the feet of the folding and inserting machine, the Examiner alleges that Haydock's clips would be used attach "the tray to cylindrical legs since Haydock's clips would provide a more secure attachment (pg. 4 of July 9, 2008 Final Office Action). There are, however, no legs shown in the figures of Tschiderer. Furthermore, even if there was motivation to provide legs to the reproduction device 10 of Tschiderer, there is no disclosure as to how the elements of Tschiderer are attached to the reproduction device 10 and the position of the pins themselves (alleged hooking means) is on lateral walls of the output tray 20 and would therefore not reach alleged legs of the reproduction device 10. Thus, there is no support for the Examiner's contention that the clips 22 of Haydock would provide a "more secure" attachment (i.e., no strength comparison can be made). Also, based on the fact that the fan fold paper feeding device 12 includes the motor driven tractor drive assembly 16 (and the closed loop tractor chains) that transports the fan fold paper 14 to the output tray 20, one skilled in the art would not be motivated to arbitrarily move the entire structure from its current position at the upper portion of the side of the reproduction device 10, down to the lower portion where alleged feet would be provided since the mechanical assembly would need to be extended. This would unnecessarily complicate the system.

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Claim 1 further recites, "said support plate includes two hollows provided on either side of its longitudinal axis at a level at which the support plate is joined with said front wall."

The Examiner acknowledges that Tschiderer fails to disclose the claimed hollows, but contends that Ladds does. The Examiner refers to column 2 et seq. of Ladds and maintains that the hollows are provided to allow copies to be grasped for removal such that it would be obvious to provide the hollows of Ladds in the device of Tschiderer for removal of copies (pg. 3 of July 9, 2008 Final Office Action). There is, however, no disclosure (at all) regarding the alleged hollows of Ladds, let alone that such hollows provide a certain benefit that would motivate one skilled in the art to alter the configuration of Tschiderer to include the hollows. Furthermore, based on the view provided in Figure 1 of Tschiderer, it appears that there is already a space provided between the side of the stack of fan folded paper and the side of the output tray 20 for grasping and removal. Thus, the hollows would not be necessary.

At least based on the foregoing, Appellants submit that claim 1 is patentable over the cited references.

B. Claims 2, 3, 7 and 8

Appellants submit that claims 2, 3, 7 and 8 are patentable at least by virtue of their dependency.

II. Claim 4 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable in view of Tschiderer, Ladds and Yamada (US 6,714,326)

The Examiner has rejected claim 4 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tschiderer, Ladds and Yamada '326. However, since claim 4 is dependent upon claim 1 and Yamada fails to cure the deficient teachings of Tschiderer and Ladds, at least in regard to claim 1, Appellants submit that claim 4 is patentable at least by virtue of its dependency.

III. Claim 5 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable in view of Tschiderer, Ladds and Firl (US 5,454,553)

The Examiner has rejected claim 5 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tschiderer, Ladds and Firl. However, since claim 5 is dependent upon claim 1 and Firl fails to cure the deficient teachings of Tschiderer and Ladds, at least in regard to claim 1, Appellants submit that claim 5 is patentable at least by virtue of its dependency.

IV. Claim 6 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable in view of Tschiderer, Ladds and Yamada (JP 8-337349).

The Examiner has rejected claim 6 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tschiderer, Ladds and Yamada. However, since claim 6 is dependent upon claim 1 and Yamada JP fails to cure the deficient teachings of Tschiderer and Ladds, at least in

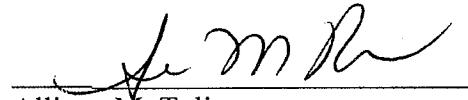
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regard to claim 1, Appellants submit that claim 6 is patentable at least by virtue of its dependency.

V. Conclusion

The USPTO is directed and authorized to charge the statutory fee (37 C.F.R. §41.37(a) and 1.17(c)) and all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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CLAIMS APPENDIX

CLAIMS 1-8 ON APPEAL:

Claim 1 (rejected): A mail item receiving device comprising:
a support plate on which ejected mail items will accumulate,
a front wall, joined to the support plate, on which these mail items will abut upon their
ejection,
two lateral walls joined to the support plate, and
a rear wall, joined to the support plate and two lateral walls, configured to align these
mail items once they have fallen on the support plate,
wherein the mail item receiving device is configured to receive the ejected mail items
from a folding and inserting machine and said support plate includes two hollows provided on
either side of its longitudinal axis at a level at which the support plate is joined with said front
wall, and
wherein each hollow creates an opening between a respective lateral wall and the front
wall and said rear wall comprises hooking means configured to cooperate with feet of a folding
and inserting machine for connecting the receiving device to the folding and inserting machine.

Claim 2 (rejected): The device of claim 1, wherein said hooking means comprise two
clips which respectively clip on to two front feet of the machine.

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Claim 3 (rejected): The device of claim 1, wherein said lateral walls each present an outer corner without sharp angle.

Claim 4 (rejected): The device of claim 1, wherein said rear wall integrating the hooking means is reinforced by ribs.

Claim 5 (rejected): The device of claim 1, wherein the device is made by moulding plastics material in one piece.

Claim 6 (rejected): The device of claim 5, wherein said lateral walls and the front wall are made of transparent material.

Claim 7 (rejected): The device of claim 1, wherein each opening allows items received on the support plate to be accessed through the opening.

Claim 8 (rejected): The device of claim 1, wherein each of the lateral walls further comprises a rounded corner located opposite the support plate and rear wall.

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EVIDENCE APPENDIX:

None

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RELATED PROCEEDINGS APPENDIX

None